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EXAMINER

KAVANAUGH, JOHN T

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 06/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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**GROUP 3700**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 35

Application Number: 09/172,830

Filing Date: October 15, 1998

Appellant(s): ZANCO, ALAIN

Mr. Ronald R. Santucci  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 7, 2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

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**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-3,5,8 and 9.

Claims 7,10 and 11 are withdrawn from consideration as not directed to the elected non-elected species.

Claims 4 and 6 have been canceled.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct. Although the examiner has withdrawn the rejection of claims 1-3 and 9 rejected under 35 U.S.C. 102(b) to Donnadieu '006 and the rejection of claims 3 and 5 rejected under 35

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U.S.C. 103(a) as being unpatentable over Bourque '202 in view of Donnadieu or Gladek inasmuch as these claims were rejection twice.

**(7) Grouping of Claims**

The rejection of claims 1-3,5,8 and 9 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

<b>4,674,202</b>	<b>BOURQUE</b>	<b>6-1987</b>
<b>4,246,708</b>	<b>GLADEK</b>	<b>1-1981</b>
<b>5,884,420</b>	<b>DONNADIEU</b>	<b>3-1999</b>
<b>4,186,500</b>	<b>SALZMAN</b>	<b>2-1980</b>

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The specification objection is not a rejection and therefore has not been repeated inasmuch as this is a petitionable matter.

***Claim Rejections - 35 USC § 112***

Claims 1-3,5,8,9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "interlocking surface means" is unclear and indefinite since it is not clear if applicant is trying to invoke 112, 6<sup>th</sup> paragraph.

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for " or "step for ";
- (B) the "means for " or "step for " must be modified by functional language; and
- (C) the phrase "means for " or "step for " must not be modified by structure, material or acts for achieving the specified function. Applicant fails to have the first two steps of the 3-prong analysis.

Moreover, applicant's specification does not adequately describe the corresponding structure, material, or acts necessary to support a claim limitation which invokes 35 USC 112, sixth paragraph and therefore it is unclear what structure such language encompasses.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1,2,8 are rejected under 35 U.S.C. 102(b) as being anticipated by 4674202 (*Bourque*).

Bourque teaches a boot having structure substantially as claimed including the sole have a first rigid part (the first half of the sole is rigid because of element 10 which is rigid in areas 14 and 16) and the rest of the sole is flexible. The front half of the rigid part (10) has grooves (28) that permit the front half of the sole to be flexible. The sole of Bourque has a profiled part (the cutout as shown in the rear of sole in figure 2). This profiled part is inherently capable as functioning as an interlocking surface as claimed.

2. Claims 1-3 is/are rejected under 35 U.S.C. 102(b) as being anticipated by *US 4246708 (Gladek)*.

Gladek teaches a boot having structure substantially as claimed including the sole have a first rigid part in the rear region that encloses the heel and the rest of the sole being flexible. The front half of the sole is flexible due to the apertures (10) that permit the front half of the sole to flex. The outer surface of the rigid sole part is inherently capable as functioning as an interlocking surface inasmuch as a binding is capable of lacking on to this surface.

3. Claims 1-3,9 is/are rejected under 35 U.S.C. 102(e) as being anticipated by *US 5884420 (Donnadieu)*.

Donnadieu teaches a boot having structure substantially as claimed including the sole have a rigid part (3) in the rear region that encloses the heel and the rest of the sole (15) being flexible. All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art

apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. The outer surface of the rigid sole part serves as the interlocking surface.

### ***Claim Rejections - 35 USC § 103***

4. Claims 5 and 8 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over either [Donnadieu '420 or Gladek] in view of Bourque '202 and US 4186500 (Salzman).

Donnadieu and Gladek all teach a boot (cross-country boots) substantially as claimed except for a cutout/profile part in the rigid sole part of the boot. Bourque and Salzman both teach cross-country boots have a rear cutout portion (or a profile part). It would have been obvious to provide the boot of either Donnadieu or Gladek with a cutout portion, as taught by Bourque and Salzman, to provide reinforcement to the sole of the boot and to facilitate securing to a binding.

**(11) Response to Argument**

**35 USC 112 Rejection**

It is clear from appellant remarks "claim has been amended to recite the interlocking surface means in a means plus function format", amendment filed Nov. 7, 2001, page 3, the last line. However, appellant's specification does not adequately describe the corresponding structure, material, or acts necessary to support a claim limitation which invokes 35 USC 112, sixth paragraph and therefore it is unclear what structure such language encompasses.

Appellant argues "that the term 'interlocking surface means' conveys a clear meaning to a practitioner in this art when the term is read in the context of the rest of the claims and in light of the specification. Moreover, Applicant urges that this language is precise in view of the nature of the claimed subject matter. The term 'interlocking surface means' is used in claim 1 to refer to the embodiment which is represented in Figures 7 and 8 as reiterated above".

In response, the phrase "interlocking surface means" cannot be found in the specification so it is not clear of the precise meaning of this phrase. Moreover, since applicant is invoking 35 USC 112, sixth paragraph, one of ordinary skill in the art should be able to determine what such language encompasses. Appellant states "The term 'interlocking surface means' is used in claim 1 to refer to the embodiment which is represented in Figures 7 and 8 as reiterated above". However, figures 7 and 8 which are directed to a species not elected, see paper #5 wherein the applicant elected Species I (figures 1, 3 and 4).



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Appellant argues "it is clear that the term 'an interlocking surface means' refers to other ski binding means which is cable of being locked into the notches of the binding of the boot to a ski or skate".

In response, appellant first states that this term refers to embodiment shown in figures 7 and 8 and then goes on to state that is refers to other ski binding means. So which one is it? The specification states "These binding means may be, for example, depending on the type of binding used, pins, a rail or a different profiled part", page 4, the last three lines. Applicant figures show multiple types of different binding means used. Therefore, the scope of this claim language is unclear and applicant's remarks make it even further unclear as to what the scope is. If applicant is trying to invoke 35 USC 112, sixth paragraph then the specification should be adequately describe the corresponding structure, material, or acts necessary to support this claimed limitation.

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35 USC 102 rejections

Appellant argues that Bourque, Gladek and Donnadieu do not inherently teach the interlocking surface means as claimed.

In response, it is noted that none of the patents show the binding means as shown by figures 7 and 8 (a species non-elected by applicant). However, they all do show structure that is inherently capable as serving as the interlocking surface means (as understood) as claimed. Moreover, Bourque has a cutout in the rear part of the sole much like applicant's cut-out (7) shown in figures 3 and 4 (the elected embodiment).

35 USC 103 rejections

Applicant argues that there is no motivation or suggestion to combine the references. The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one of ordinary skill in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, evaluating the obviousness of an invention under Section 103 is to consider not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989) and In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary

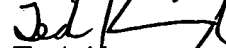
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skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what is fairly teaches one of ordinary skill in the art, including not only specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See In re Bos, 355 F.2d 961, 148 USPQ 507 (CCPA 1966); and In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968). In this case, Salzman and Bourque both teach cross-country ski boots which both show a cut-out in the rear section of the sole. Neither patent teaches what this cut-out is for but it is obvious to one of ordinary skill in the art that these cut-outs are used to facilitate securing the shoe to a binding.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

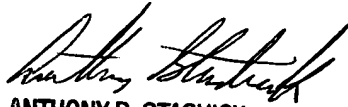


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June 25, 2002

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